

### **REMARKS**

The paper is in response to the Office Action mailed May 12, 2010 ("the Office Action"). The foregoing amendment amends claims 23, 53, 56, and 73; cancels claims 73-75, 80, 81, and 83-86; and adds new claims 89-91. Claims 1-6, 8, 9, 11-15, 23, 27-37, 39-41, 43-64, 66-72, and 87-91 are now pending in view of the amendments. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

### **Rejection under 35 U.S.C §103(a)**

The Office action rejects the claims under 35 U.S.C §103(a) as follows:

- Claims 1, 4-6, 8-9, 11, 23, 27-36, and 87 are rejected as being unpatentable over *Jibbe* (U.S. Patent No. 6,687,856) in view of *Mitchell et al.* (U.S. Patent Publication No. 2003/0174694) in further view of *Ellis et al.* (U.S. Patent No. 6,191,713);
- Claims 2 and 3 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, and in further view of *Nelson et al.* (U.S. Patent No. 6,928,108);
- Claim 12 is rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, and in further view of *Bucher et al.* (U.S. Patent Pub. No. 2001/0016925);
- Claims 13-15 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, and in further view of *Blatter et al.* (U.S. Patent No. 6,236,694);
- Claims 37, 39-41, 43, 44, 46, and 49-55 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, *Bucher*, and in further view of *Blatter*;
- Claim 45 is rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, *Bucher*, *Blatter*, and in further view of *Dwyer* (U.S. Patent No. 6,820,251);
- Claims 47-48 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, *Bucher*, *Blatter*, and in further view of *Rivoir* (U.S. Patent No. 6,105,087);
- Claims 56-64, 66-72, and 88 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Ellis*, and *Rivoir*;
- Claims 73 and 76-81 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Blatter*, and *Ellis*;
- Claims 74-75 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Blatter*, *Ellis*, and in further view of *Nelson*;
- Claims 82, 85-86 are rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Blatter*, *Ellis*, and in further view of *Noy* (U.S. Patent No. 7,114,111);
- Claim 83 is rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Blatter*, *Ellis*, and in further view of *Lee et al.* (U.S. Patent No. 6,377,643); and

- Claim 84 is rejected as being unpatentable over *Jibbe* in view of *Mitchell*, *Blatter*, *Ellis*, and in further view of *Bucher*.

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Finally, MPEP 2141.III notes that:

The key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.*** The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that ***"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."*** *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

(Emphases added.)

As an initial matter, Applicants respectfully note that the rejection of claims 73-75, 80, 81, and 83-86 is rendered moot in light of the cancellation of those claims.

Claim 1 recites an analyzer comprising replay logic configured to output one or the other of transmission medium activity and stored activity to trigger logic, "wherein the trigger logic includes a trigger sequencer that uses a state machine architecture configured to change states and each level of the state machine can enable any or all of the other levels upon exiting the level." Applicants respectfully submit that the prior art, whether considered individually or in combination, fails to teach or suggest the foregoing limitations.

For example, the Examiner concedes that *Jibbe* and *Mitchell* do not explicitly teach the foregoing limitations. *See Office Action* at 5. The Examiner relies instead on *Ellis* for its description of "conversion commands using a state machine by implementing a state machine

providing a plurality of states....” *See id.* The Examiner then concludes that it would have been obvious to modify the analyzer of *Jibbe* and *Mitchell* “by adding Ellis et al. conversion commands using a state machine.” *See id.*

However, *Ellis* describes using a state machine circuit in the context of converting communications between a parallel port and a serial bus device. The trigger logic of the *Jibbe-Mitchell* combination does not appear to suffer any deficiencies in terms of communicating between a parallel port and a serial bus device. Therefore, *Ellis* does not teach or suggest modifying trigger logic in the analyzer of the *Jibbe-Mitchell* combination to include “a state machine architecture configured to change states,” as claimed. Instead, *Ellis* at best suggests using a state machine circuit in a USB-to-parallel port interface. *See Ellis* at col. 12, lines 11-16.

The Examiner asserts that it would have been obvious to modify the analyzer of *Jibbe* and *Mitchell* in light of the teachings of *Ellis* “because it would provide an efficient method for communication and conversion between busses and port commands.” However, as noted above, the analyzer of *Jibbe* and *Mitchell* does not appear to suffer any deficiencies in terms of communicating between a parallel port and a serial bus device. Accordingly, no reason exists for one of ordinary skill in the art seeking to improve the trigger logic in the analyzer of *Jibbe* and *Mitchell* to look to the unrelated teachings of *Ellis* with respect to a USB-to-parallel port interface.

Moreover, *Ellis* fails to provide the necessary disclosure of a state machine in which “each level of the state machine can enable any or all of the other levels upon exiting the level,” as claimed. Instead, *Ellis* states, “The state machine circuit transitions from one of the states to any one of the states in response to a change condition....” *See id.* at col. 2, lines 5-8 (emphasis added).

Claim 37, although of different scope than claim 1, recites similar details of a trigger sequencer.

Claim 23 recites an analyzer that comprises trigger logic, “wherein the trigger logic includes a trigger sequencer that uses a state machine architecture configured to change states, and wherein the trigger logic allows a user to program the trigger sequencer to enable different

states.” In rejecting claim 23, the Examiner again relied on a combination of *Jibbe*, *Mitchell*, and *Ellis*. See *Office Action* at 9 (“Refer to claim 1 for motivational statement.”) However, as noted above in the discussion of claim 1, no reason exists for one of ordinary skill in the art seeking to improve the trigger logic in the analyzer of *Jibbe* and *Mitchell* to look to the unrelated teachings of *Ellis* with respect to a USB-to-parallel port interface.

Moreover, *Ellis* fails to provide the necessary disclosure of trigger logic that “allows a user to program the trigger sequencer to enable different states,” as recited in claim 23.

Claim 56, as amended, recites an analyzer comprising “a trigger sequencer configured to use a state machine architecture to trigger on an event, wherein the state machine architecture is configured to change states between 12 levels of state and each level of the state machine can enable any or all of the other levels upon exiting the level and all 12 states can be enabled simultaneously.” In rejecting claim 56, the Examiner again relied on a combination of *Jibbe*, *Mitchell*, and *Ellis*. See *Office Action* at 26. However, as noted above in the discussion of claim 1, no reason exists for one of ordinary skill in the art seeking to improve the trigger logic in the analyzer of *Jibbe* and *Mitchell* to look to the unrelated teachings of *Ellis* with respect to a USB-to-parallel port interface.

In light of the foregoing, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claims 1, 23, 37, or 56. Accordingly, withdrawal of the rejection of claims 1, 23, 37, and 56, and their corresponding dependent claims is respectfully requested.

### **New Claims 89-91**

To further distinguish Applicants’ invention from the prior art, Applicants have added new claims 89-91 dependent from claim 23. Support for new claim 89 may be found at least in paragraph 33 of the original specification. Moreover, support for new claims 90 and 91 may be found at least in Figure 5 and in paragraph 32 of the original specification. Claims 89-91 are submitted to be in condition for allowance at least by virtue of their dependence from allowable claim 23.

### **Charge Authorization**

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

### **CONCLUSION**

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 11<sup>th</sup> day of August 2010.

Respectfully submitted,

/Ronald J. Ward/Reg. No. 54,870

RONALD J. WARD

Registration No. 54,870  
Attorney for Applicant  
Customer No. 022913  
Telephone: (801) 533-9800